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09/447,052

11/23/1999

SEISHI SUEHIRA

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10/19/2004

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EXAMINER

NGUYEN, CHAU T

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/447,052

Applicant(s)

SUEHIRA, SEISHI

Examiner

Chau Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/29/2004 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-3, 7-12, 56-58, 60 and 63 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims 1-3, 7-12, 56-58, 60 and 63 contain subject matter "file-system" which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim Objections

4. Claims 1, 56-58 and 63 are objected to because of the following informalities: claim 1 contains "adding entity declarations" in line 25 should be rewritten as "adding the entity declarations"; claims 56-58 have the same errors; and claim 63 contains "preparing a hub-document" in line 21 should be rewritten as "preparing the hub document". Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-63** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,377,956 B1 to Hsu et al., issued April 23, 2002, filed February 22, 1999 in view World Wide Web Consortium, *XML Schema Part I: Structures*, W3C Working Draft (May 6, 1999). With respect to the rejection of each dependent claim below, the preceding rejection(s) of the relevant base claim(s) is incorporated therein.

Regarding **independent claims 1, 49, 56 and 63**, Hsu et al. teach setting in advance an original document storage file-system directory for storing the non-

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structured documents inasmuch as they teach specifying database tables or external files for the storage of component documents. (Hsu et al., col. 3, lines 20-44 and col. 7, lines 26-32: the component document retriever for storing the component documents in various subdirectories of a machine-specific directory) Hsu et al. also teach setting in advance a structured document file-system directory area for storing structured documents obtained by conversion of the non-structured documents. (Hsu et al., col. 8, lines 16-18: "In the media preparation process, all source documents are processed and converted into standard formats, in particular, SGML, and are stored in the document database.")

Further, Hsu et al. do not explicitly teach but it would have been obvious to one of ordinary skill in the art to store the non-structured document into the original storage file-system directory each time it was prepared or edited because it would have been obvious to one of ordinary skill that it would be desirable to have the most updated version of the non-structured document available for conversion to a structured document. (Hsu et al., col. 8, lines 16-18, quoted above.)

Further, Hsu et al. teach converting the non-structured documents into structured documents and storing them in the structured document storage file-system directory. (Hsu et al., col. 3, lines 20-44 and col. 8, lines 16-18.)

Further, Hsu et al. disclose a configuration process that assembles a set of related product documents may be automated more efficiently and effectively (col. 7, line 33 – col. 8, line 25). However, Hsu et al. do not teach acquiring

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document names of the structured documents and preparing corresponding entity declarations referring to the structured documents. However, *XML Schema Part 1* teaches in section 3.6.2 on page 38 external parsed entities, “a feature of XML that offers a method for including well-formed XML document fragments, including text and markup, by direct reference to the storage object of the parsed entity.” Further, in the example at the top of page 39, *XML Schema Part 1* depicts entity declarations containing the names of structured documents. One of ordinary skill in the art would have recognized that these entity declarations provide a straightforward and efficient way to refer to component documents, and therefore, it would have been obvious to one of ordinary skill in the art to extend Hsu et al. to acquire document names of the structured documents and prepare entity declarations for referring to entities of the structured documents.

Further, Hsu et al. disclose do not teach adding entity declarations to the hub document responsive to the presence of the structured documents in the structured document file-system directory. However, *XML Schema Part 1* in the example in section 3.6.2 on page 39 depicts a hub document based on the entity declarations regarding the structured documents. Moreover, one of ordinary skill in the art would have recognized that basing a hub document on the entity declarations would have provided the benefit of flexible and efficient document production, allowing reuse of components in different documents and ensuring that the most up-to-date versions of components were used. Therefore, it would

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have been obvious to one of ordinary skill in the art to prepare the hub document based on the entity declarations regarding the structured documents.

Regarding **dependent claims 2, 50 and 57**, Hsu et al. teach an attachment file storage area set in advance, and storing attachment files into the storage directory, inasmuch as they teach the original file storage directory as discussed above regarding claim 1 and further state that “[m]edia files, which are also document objects, are also managed in the same way as component documents.” (Hsu et al., col. 3, lines 20-44 and col. 7, lines 25-26.) Further, Hsu et al. do not teach preparing entity declarations for the attachment file or preparing the hub document based on the entity declarations for the attachment files as well as the entity declarations for the structured documents, but these elements would have been obvious to one of ordinary skill in the art in view of *XML Schema Part I* under the same rationale stated above regarding claim 1 for the obviousness of creating entity declarations and preparing the hub document based on the entity declarations regarding the structured documents.

Regarding **dependent claims 3, 51 and 58**, the rejection of claim 2 above is fully incorporated herein. Further, Hsu et al. do not teach setting in advance an entity declaration storage directory. However, in view of the obviousness of using entity declarations, discussed above regarding claim 1, it further would have been obvious to one of ordinary skill in the art to have set in advance an entity storage area because one of ordinary skill would have recognized the benefit of having a central storage area from which entity declarations could be accessed and used for multiple documents.

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Regarding **dependent claims 4-6, 52 and 59**, Hsu et al. do not teach the entity declarations of the structured documents having file names corresponding to the file names of the original unstructured document. However, one of ordinary skill in the art would have recognized that giving entity declarations the same names as the original unstructured document would have had the benefit of making clear to what original document the entity declaration referred, and therefore the step recited in these claims would have been obvious to one of ordinary skill in the art.

Regarding **dependent claims 7-12, 53 and 60**, Hsu et al. do not teach the entity declarations for the attachment files having file names corresponding to the file names of the non-structured documents to which the attachment files are attached. However, one of ordinary skill in the art would have recognized that giving attachment entity declarations the same names as the original unstructured document would have had the benefit of making clear to what original document the attachment was attached, and therefore the step recited in these claims would have been obvious to one of ordinary skill in the art.

Regarding **dependent claims 13-24, 54 and 61**, Hsu et al. teach the attachment files being graphic files including graphic information. (Hsu et al., col. 7, lines 61-65: "For each component document, the author also prepares for all needed multimedia files for diagrams, images, drawings, etc. in some standard formats such as CGM, TIFF, GIF, etc., which may be incorporated in the SGML files.")

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Regarding **dependent claims 25-48, 55 and 62**, Hsu et al. teach that the structured documents a Standard Generalized Markup Language (SGML) documents whose structure is defined by a Document Type Definition (DTD). (Hsu et al., col. 7, lines 33-37: "Component documents are preferably represented in SGML (See SGML: Standard Generalized Markup Language, ISO/IEC 8879:1986). SGML is a meta-language for defining document structures, referred to as Document Type Definition (DTD). An SGML document structure is an instance of its associated DTD.")

Response to Arguments

In the remarks, Applicant argued in substance that

A. "Prior art does not disclose or suggest entity references determined according to files in a file-system directory"

7. As to point (A), in response to applicant's arguments, the recitation "entity references" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

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8. Suppose entity declarations are read as "entity references" or "document references", then in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Hsu et al. disclose do not teach adding entity declarations to the hub document responsive to the presence of the structured documents in the structured document file-system directory. However, *XML Schema Part I* in the example in section 3.6.2 on page 39 depicts a hub document based on the entity declarations regarding the structured documents. Moreover, one of ordinary skill in the art would have recognized that basing a hub document on the entity declarations would have provided the benefit of flexible and efficient document production, allowing reuse of components in different documents and ensuring that the most up-to-date versions of components were used. Therefore, it would have been obvious to one of ordinary skill in the art to prepare the hub document based on the entity declarations regarding the structured documents.

9. Applicant's arguments filed 06/29/2004 have been fully considered but they are not persuasive. Please see the rejection and response to arguments above.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau Nguyen whose telephone number is (703) 305-4639. The Examiner's future phone number is (571) 272-4092, which will be effective sometime in October 2004. The Examiner can normally be reached on Monday-Friday from 8:00 am to 5:00 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Joseph Feild, can be reached at (703) 305-9792.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chau Nguyen
Patent Examiner
Art Unit 2176


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER